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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/945,705 | 02/23/1997 | MICHIYA YAMADA | JP6-131165 | 3016 |

7590

08/07/2002

EXXONMOBIL RESEARCH AND ENGINEERING COMPANY
P.O. BOX 900
ANNANDALE, NJ 08801-0900

EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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06/27/2002

EXXON RESEARCH AND ENGINEERING COMPANY
P O BOX 390
FLORHAM PARK, NJ 079320390

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18

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 08/945,705 | Applicant(s) YAMADA ET AL. | |
| | Examiner Margaret B. Medley | Art Unit 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the remand by the Board of Appeals and Interferences filed on October 17, 2001, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The amendment to claim 2 filed by applicants on February 22, 1999, Paper No.10, does not comply with the requirements of 37 CFR 1.121 failing to provide the required underlining and/or bracketing for "The" at line 20 and for "contained" at line 24. Applicants are reminded that amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

(c) Claims.

(1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

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(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Failure to comply with 37 CFR 1.121 will result in an abandonment of the instant application.

The finality of the previous office action and the previous 103 rejection are withdrawn to clarify the record that the amendment to claim 2 as requested by applicants in Paper No. 10 dated February 22, 1999 has not been entered, to address the Board of Appeals and Interferences concern with respect to the grounds of rejection and to entered new grounds of rejection. Applicants are notified that the proper procedures for amending a claim is set forth in supra and is not repeated herein.

Claim 2 is objected to because of the following informalities: The term "atom." In line 13, should be corrected for its spelling. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 2 is indefinite and confusing for the (B) zinc dialkyldithiophosphate component Markush grouping limitation that appear to be inconsistent with the disclosure set forth at the paragraph bridging pages 6 and 7 of the instant application. Claim 1 is further indefinite and confusing for the 0.05-0.06 % boron content that is inconsistent with the 0.005-0.006 % boron content set forth in the first full paragraph on page 9 of the instant application. The said range has not been explicitly set forth in the instant application disclosure and appears to be a typo. Clarification to the record is requested as to the claimed range. Applicants' attention is directed to Table 2 of the instant application wherein data have been presented for 0.016 % boron content as showing for unexpected results. The said 0.016 % boron content appearing in Table 3 is clearly outside of the instant claimed 0.05-0.06 % range content and cannot be relied upon to show unexpected results. Therefore, claim 2 will not be treated on the merits until clarification as to the scope of pending claim 2 has been established on the record..

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-6 and 8 of co-pending Application No. 08/987,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim directed to a lubricant composition comprising DTC, ZDTP and alkylate salicylate and a lubricating oil that encompass the specific lubricating oil blend of the co-pending application, and the claims of the co-pending application contains the open-ended language "comprising" which would not exclude the alkylsalicylate component of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al (Igarashi) 5,281,347 in view of Papay et al (Papay) 4,178,258 and Umemura et al (Umenura) 4,692,256 and White et al (White) 4,330,420.

Igarashi teaches and disclose a lubricant oil composition for internal combustion engines (INE) comprising a lubricating oil, column 2, lines 17-29, a molybdenum dithiocarbamate (MoDTC) with 0.007 wt. % Mo, column 5 the footnote at the end of the Table 1 and claim 1, and provides for the further inclusion of an SG grade package additive, column 5, lines 20-21. Patentee further teaches known lubricant additives that may be added to the lubricating composition that include zinc dithiophosphates (ZDTP), alkaline-earth metal sulfonates, phenates, salicylates and phosphates, ashless dispersants, and antioxidants, column 4, lines 3-16. Igarashi further teaches that the total additives are employed in preferably less than 25 parts by weight of the base oil, column 4, lines 17-25.

The instant claims are specific to the phosphorus content of the ZDTP being from 0.04-0.15 % by weight wherein the prior art is silent to said teachings.

It is the examiner's position that the relative proportion of phosphorous of the instant claims would be obvious in view of Papay, Umemura and White. Papay, teaches 0.005-0.5 wt % zinc from ZDTP, column 53-65 and 0.01mo from MoDTC, column 3, lines 40-45 and further provides for the further inclusion of conventional lubricant additives including calcium detergents, column 3, lines 4-8. Umemura teaches

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and discloses lubricant oil composition comprising 0.06 wt % Mo from MoDTC, column 10, line 46-50, and 600 ppm sulfur from ZDTP wherein the phosphorous content would be within the same range, note Table 3 of column 11-12 and the footnote at the end of the table. Patentee further provides for the inclusion of detergents of calcium, magnesium etc, note column 5, lines 58-68. White teaches that by 1985 in the U.S. some car manufacturers will require phosphorous levels to be of 0.05 % from ZDTP in motor oil formulations, column 1, lines 26-34. It would be obvious to the artisan in the art to use the ZDTP to produce phosphorous of 0.005-.05 % preferably as low as 0.05 % of the secondary references in the lubricant composition of the primary reference rendering the instant claims obvious because the instant claimed phosphorous level are known in motor oil formulations as taught by the secondary reference. It is the examiner's position that the 0-50 % by weight of magnesium alkylsalicylate reads on the compound being optional and is not required. The less than 25 wt % alkaline-earth metal salicylates of Igarashi render the 0.5 to 10 % by weight salicylate of the instant claims obvious. It is the examiner position that the lubricant oil would have a total base number of 3 to 10 since the Mo content, Zn content and salicylate content are present in the composition in the same relative proportion as that of the instant claims. It is further noted on record that the instant claims contain the open-ended language "comprising" at line 2 and would not exclude the additives of the prior art from being present in the lubricant composition.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Inoue et al (Inoue) 5,744,430. Inoue teaches and discloses lubricant composition comprising a base oil, column 2, line 26 to column 3, lines 15-16, 0.5 to 1.2 % by weight calcium salicylates, 0.04 to 0.10 % by weight of phosphorous from ZDTP, 0.02 to 0.15 % by weight of Mo from MoDTC, succinimide and a VI improver which anticipates the instant claims. It has been held that a claim is anticipated if the claim ranges overlap the prior art ranges as has been shown by the teachings of Inoue. It is further noted that claim 1, at line 2 contain the open-ended language "comprising" and therefore would not exclude the other components of the prior art from being present in the lubricant composition of the instant claims.

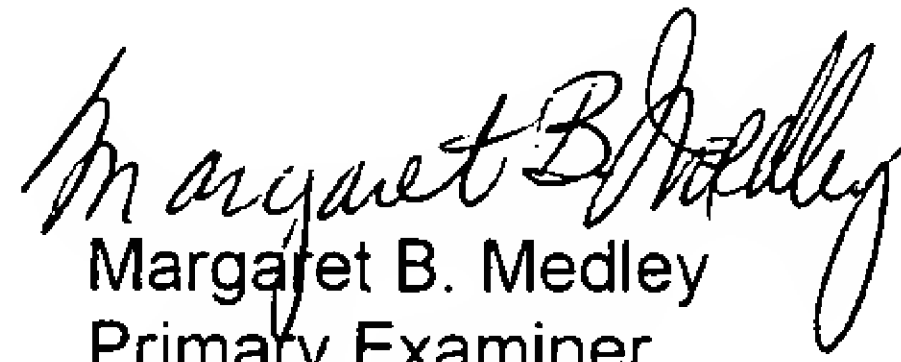
The prior art submitted by applicants, Paper No. 15, dated July 1, 1999 has been reviewed and reconsidered and made of record. The prior art made of record and not relied upon further teaches lubricant oil compositions comprising additives of the same nature as claimed by applicants. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vas Jagannathan, can be reached on (703) 306-2777. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

Margaret B. Medley

June 4, 2002